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Attorney Docket No. 01064.0011-04-000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Richard LEVY

Serial No.: 09/357,957

Filed: July 21, 1999

For: LUBRICANT COMPOSITIONS AND
METHODS

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) Group Art Unit: 1714

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) Examiner: Cephia D. Toomer
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Commissioner for Patents
P.O. Box 1450
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Sir:

APPELLANT'S REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Appellant submits this Reply Brief pursuant to 37 C.F.R. § 41.41 in response to the December 14, 2007 Examiner's Answer.

The examiner has changed the status of the claims from her Final Rejection of April 11, 2006, by allowing and objecting to some claims for the first time in her Answer, but not without remarking appellant's brief "incorrectly" gave the status of the claims, in spite of the fact the status recited in the brief was identical to what she originally set out in her April 11, 2006 Final Rejection. The examiner also maintained her rejections and objections to some of the claims which appellant will address in this reply brief.

The Rejection of the Claims Under 35 U.S.C. § 102(b)

The examiner maintains the rejection of claims 29, 31, 32, 68, 72, 73, 85, 93, and 95-97 under 35 U.S.C. § 102(b) based on Takayama, United States Patent No. 5,792,717. Appellant traverses the rejection for the same reasons given in his Brief on Appeal.

The Rejection of the Claims Under 35 U.S.C. § 103(a)

The examiner maintains the rejection of claims 29, 31, 34-38, 41, 42, 48, and 53 under 35 U.S.C. § 102(a) based on Johnson, United States Patent No. 5,275,760 in view of Obayashi, et al., United States Patent No. 4,340,706 ("Obayashi"). Appellant traverses the rejection for the same reasons given in his Brief in Chief, and for the following reasons.

Johnson has to be viewed to determine if appellant's lubricant composition can be substituted for the two compositions used in Johnson, namely, (1) an aqueous solution of a corrosion inhibitor (Johnson col. 2, par. 1) and (2) a slurry of oil and a polymer or "hydrogel." (col. 2, par. 2). Johnson pumps the slurry (2) into an annular region in a pipeline in a way to leave an unoccupied volume in the region, and then pumps the solution (1) into the unoccupied volume at a rate which avoids displacing the slurry (2) from the annular region (col. 5, lines 36-43). Density differences between the oil layer, i.e., slurry (2) and the aqueous solution (1) buoy the oil layer (2) and sinks the aqueous layer or solution (1) (col. 5, lines 43-46). Contacting over a period of time, e.g., 12 to 48 hours, results in gelation of the aqueous layer. (col. 5, lines 50-54). Johnson therefore forms two layers. Nothing in appellant's claims suggest a composition in two layers. Because it is a two layer system, it would not teach or suggest appellant's claimed composition. Johnson relies on the aqueous layer to contain the carbonate or other corrosion inhibitor so it can function as an anti-corrosion agent. The carbonate therefore must remain behind in the aqueous solution, indicating it would not combine with the polymer in the oil slurry. Appellant, however, combines the carbonate with the superabsorbent polymer, which Johnson

does not appear to do. This shows that Johnson neither teaches nor suggests appellant's claimed invention.

Appellant's written description furthermore shows that the claimed composition comprises a homogeneous composition as distinguished from Johnson's anti-corrosion compositions.

The examiner points out "Johnson differs from the claims in that the patentee does not specifically teach appellant's intended use. However, intended use is given little patentable weight in claims that are directed to the composition per se." (December 14, 2007 Examiner's Answer, p. 5, 3rd par.)

On the contrary, the recitation of intended use in the preamble of the claims ("lubricating composition") distinguishes Johnson. The effect of the preamble language should be resolved only on review of the entirety of the application to gain an understanding of what appellant invented and intended to encompass by the claims. Here, appellant's written description makes clear that he was working on the problem of developing an effective lubricant with superabsorbent polymers. To read the application indiscriminately to cover all uses of superabsorbent polymers, such as Johnson's two-layer oil-aqueous solution corrosion inhibitor amounts to speculation or hindsight application of the Johnson teachings. Appellant has restricted his invention to lubricant compositions as defined in the written description and not the two-layer corrosion inhibitor of Johnson. Accordingly, the claim preamble "lubricant composition" does not merely state a purpose of intended use for the claimed compositions.

Coming Glass Works v. Sumitomo Electric U.S.A. Inc., 868 F.2d 1251, 1257, 9 USPQ 2d 1962, 1966 (Fed. Cir. 1989). See Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The "lubricant composition" preamble gives "life and meaning" and provides further positive limitations to the claimed invention, i.e., it excludes the corrosion inhibitor compositions of Johnson. See Loctite v. Ultraseal Ltd., 781 F.2d 861, 866, 228 USPQ 90, 93 Fed.Cir. 1985); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed.

Cir.), cert. denied, 469 U.S. 857 (1984). Contrary to the examiner's implication, the elements of the claim following the "lubricant composition" preamble are not the only limitations to the claims. The preamble also limits them to "lubricant compositions" and excludes the anti-corrosion compositions of Johnson. See Diversitech Corp. v. Century Steps, Inc., 850 F. 2d 675, 677-78, 7 USPQ 2d 1315, 1317 (Fed. Cir. 1988).¹ The claim requires the particular mixture set out in the written description to function as a lubricant as opposed to the Johnson anti-corrosion compositions.

The Examiner's Response to Argument

In addressing appellant's arguments that Takayama, United States Patent 5,792,717 does not teach appellant's claimed composition because the patentee does not describe the use of particulate boron nitride as a lubricant, but rather as a monolithic ceramic surface, the examiner responds "that appellant's claims do not exclude forming a ceramic body from the particulate boron nitride." (Examiner's Answer, p. 6, last two lines.) (Emphasis added.) Appellant responds by pointing out that the claims also do not claim forming a ceramic body from particulate boron nitride.

The examiner also reargues that "Takayama teaches that the ceramic body exhibits an outstanding self-lubricating property. . . ." (Examiner's Answer, p. 7 par. 1.) (Emphasis in original.) Appellant pointed out in the Brief in Chief that the lubricating properties of the Takayama boron nitride ceramic depended on the porosity of the ceramic wherein bodies with relatively high pore volume absorbed more water and had higher lubricating properties than comparable ceramics with lower pore volume that consequently absorbed less water. These teachings of Takayama clearly show that the patentee ascribed lubricating properties of the ceramic body to water, and not boron nitride.

¹ See generally Manual of Patent Examining Procedure § 2111.02

More important, however, is the examiner's statement that "[w]ith respect to Takayama not teaching a "particulate" lubricant composition; the present claims do not set forth that the lubricant composition is a "particulate" lubricant composition. (Examiner's Answer, p. 7, par. 1).

Since the claims call for a "particulate lubricating metal nitride" (claim 1, and the Examiner's Answer previously referred to appellant's "particulate boron nitride" (Examiner's Answer, p. 6, par. 3.) (Emphasis added.)), appellant regards this comment as pertaining to the balance of the lubricating materials recited in the claims. Appellant does not have to describe the physical nature of the rest of the lubricant materials in the same manner as the boron nitride since these materials can take various forms. Appellant adopted the claim definition of the boron nitrides for the specific purpose of differentiating the monolithic boron nitride of Takayama from the particulate boron nitride employed in appellant's invention, and showed support in the application for this parameter. Takayama did not restrict the meaning of appellant's other lubricating materials in this way and accordingly appellant does not have to distinguish them in this manner.

The examiner further argues that since Johnson teaches a carbonate, the reference teaches appellant's carbonate lubricants. As pointed out before, Johnson describes carbonates as a corrosion inhibitor in an aqueous solution. He contacts the aqueous solution with a slurry of polymer in oil but is mute as to whether the carbonate in the aqueous solution combines with the polymer in the oil slurry. The aqueous solution remains in the Johnson composition so it can function as a corrosion inhibitor so it appears that the carbonate does not combine with the polymer. By contrast, appellant combines the carbonate as a lubricating material with a superabsorbent polymer in order to obtain one of the appellant's claimed lubricating compositions, contrary to the corrosion inhibitor composition of Johnson. Lastly, Johnson does not acknowledge carbonates as lubricating materials, and Johnson makes no mention at all that

he formulates lubricating compositions as an objective of his invention. He produces a corrosion inhibiting composition in stead.

Conclusion

In conclusion, appellant requests the board to reverse the examiner in all respects and remand the application to the examiner. At a minimum, on remand, the examiner has to issue a Notice of Allowance as to the unrejected claims and the claims the examiner objected to. Appellant will amend the claims objected to and incorporate in them any limitations of the claims from which they depend.

Respectfully submitted,

THE LAW OFFICES OF ROBERT J. EICHELBURG

February 14, 2009

By:


Robert J. Eichelburg

CERTIFICATE OF FACSIMILE TRANSMISSION PURSUANT TO 37 C.F.R. § 1.6 (d)

I hereby certify that this correspondence is being transmitted pursuant to 37 C.F.R. § 1.6(d) by facsimile to The United States Patent and Trademark Office, Central FAX Number (571) 273-8300 on the date indicated below.

February 14, 2008

By:


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